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Petrus T. de Koning

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EXAMINER

ZHENG, JACKY X

ART UNIT

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2625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,850	<b>Applicant(s)</b> DE KONING, PETRUS T.	
	<b>Examiner</b> JACKY X. ZHENG	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on July 10, 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 25, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the office action based on a request for continued examination under 37 CFR 1.114 filed on July 10, 2008 and the amendments under 37 CFR 1.116 filed on May 29, 2008.

2. **Claims 1 and 9** have been amended.

3. **Claims 17-24** have been withdrawn from consideration as of previous record.

Note: This application contains claims 17-24 drawn to an invention nonelected species with traverse in the reply filed on September 5, 2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action. See MPEP § 821.01.

4. The rejection under 35 USC 112, second paragraph with regard to claims 9-11 (set forth in previous Office Action, specifically paragraphs 5-7) are withdrawn in view of Applicant's amendments and/or remarks to the claim(s).

### ***Request for Continued Examination (RCE)***

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 10, 2008 has been entered.

### ***Response to Arguments***

6. Applicant's arguments filed on May 29, 2008 (followed by a RCE on July 10, 2008) have been fully considered but they are not persuasive.

7. In re Applicant's remarks from pg. 7, 3<sup>rd</sup> paragraph, regarding the rejection made under 35 U.S.C. §112, second paragraph with regard to Claim 15, Applicant asserts that "...this

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*definition has been formally added to the Specification, and this Amendment is believed to overcome the rejection of claim 15 under 35 USC 112 (second paragraph)”. Applicant’s argument(s) are fully considered, however found to be not persuasive for at least the following reasons. Examiner respectfully reiterates the responses set forth previously (i.e. paragraph 9 of Office Action mailed on April 29, 2008),*

“... Applicant asserts that the claim limitation “*optically equivalent*”, the term “*should mean having substantially identical optical properties, such as in terms of overall refraction and/or transmissivity*”. Applicant’s argument(s) are fully considered, however found to be not persuasive for at least the following reasons. As the descriptions relating to the claim limitation “*optically equivalent*” provided by Applicant in ...., merely giving an *exemplary* interpretation (or instances) of such a relative limitation. In addition, such a relative phrase has not been properly depicted with any *explicit* definition in claim language for properly limiting the indefinite scope; in addition, providing merely an *exemplary* interpretation in the remarks does not constitute as an *explicit definition* (which would provide a clear description in determining the metes and bounds of such a limitation over the prior art considerations). Therefore, for at least the reasons set forth above, the rejection made under 35 U.S.C. §112, second paragraph with regard to claim 15 is remained proper and therefore maintained”.

In addition, the amendment to the specification (for paragraph 15) presented with regard to this issue, Examiner respectfully submits to be not entered for reasons in consideration under "new matters" and/or the amendment has not yet resolved the identified issue(s) as set forth previously and reiterated in instant Office Action.

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Therefore, for at least the reasons set forth above, the rejection made under 35 U.S.C. §112, second paragraph with regard to claim 15 is remained proper and therefore maintained.

8. In re Applicant's remarks from pg. 7, 4<sup>th</sup> – 5<sup>th</sup> paragraphs, regarding the rejection made under 35 U.S.C. §102(e) with regard to Claims 1-2 4 and 6-16, Applicant asserts that "... *claim 1 has been further amended above to recite "when the document handler is moved away from the main body of the apparatus, the pane moves with the document handlers, Suzuki make no suggest whatever of this feature".* Applicant's argument(s) are fully considered, however found to be not persuasive for at least the following reasons.

- a. As previously discussed (i.e. paragraph 10, section b of previous Office Action),  
"... In addition to the discussions set forth in previous office action,  
Applicant's attention is further directed to Figure 9 of Suzuki, component 70 - "a lens" for discussion of claim limitation "a light-transmissive pane" (or the pane 50 of Figure 2 as indicated by Application) required by claim 1. Examiner respectfully disagrees with Applicant's remarks of "*there is no disclosure that lens 70 is, as in claim 1 'fixedly mounted' to the document feeding unit 31, ... if unit 31 is lifted up, there is no evidence that lens 70 is lifted up with it*". See Suzuki, i.e. column 6, lines 35-45, "a lens 70 may be placed in a position opposite the conveying roller 48 on the document feeding unit 31 in the above-mentioned embodiment...", which clearly discloses the limitation of the lens 70 being placed on the document feeding unit 31. ...".

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b. Further, with respect to the newly added claim limitation of *"when the document is moved away from the main body of the apparatus, the pane moves with the document handler"*, Examiner respectfully submits that as "the lens 70" (corresponding to claimed "the pane") is disclosed to be placed on the document feeding unit 31, it will be an inherent property for the lens 70 to be moving with the document feeding unit as it is already placed in position on the document feeding unit.

c. In addition, as independent claim 1, currently drawn to "an apparatus (for recording image on sheets)", which is clearly an apparatus claim. In accordance with MPEP §2114 – Apparatus and Article Claims – Functional Language, recited "While features of an apparatus may be recited either structurally or functionally, claim directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Furthermore, the section from MPEP continues, "Apparatus claims cover what a device is, not what a device does" *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Therefore, for at least the reasons set forth above, the rejection made under 35 U.S.C. §102(e) over Suzuki with regard to claims 1-2, 4 and 6-16 is remained proper and therefore maintained.

9. In re Applicant's remarks from pg. 8, 1<sup>st</sup> paragraph, regarding the rejection made under 35 U.S.C. §103(a) with regard to Claims 3 and 5, Applicant asserts that *"these claims are deemed allowable as being dependent from claim 1"*. Applicant's argument(s) are fully considered, however respectfully found to be not persuasive. As the rejection of claim 1 (among

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others as indicated above) is maintained for reasons stated above, the grounds of rejection for claims 3 and 5 is also maintained for reasons of record since applicant has not pointed to the deficiencies of the rejection.

(The grounds of rejection and/or objection are maintained for at least the responses set forth above, reasons of record set forth previously, and also replicated and provided in below.)

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claim 15** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The phrase "optically equivalent" in claim 15 is a relative phrase, as such a limitation has not been explicitly depicted with further or sufficient descriptions in instant claim, which renders the claim indefinite. The phrase "optically equivalent" is not defined by the claim and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Also see the details in paragraph 7 in the section of "Responses to Argument" above.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. **Claims 1-2, 4 and 6-16** are rejected under 35 U.S.C. 102(e) as being anticipated by **Suzuki** (Patent No. 6,738,167).

**With regard to claim 1**, the claim is drawn to an apparatus for recording images on sheets, comprising: an image receptor, disposed in a main body of the apparatus (*see Suzuki, i.e. Figure 1 – 11, “CCD sensor”*); a document handler, for conveying each of a set of sheets past the image receptor, the document handler being movably mounted relative to the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 28, “Automatic Document Feeder”*); and a light-transmissive pane fixedly mounted relative to the document handler, and operatively disposed between a sheet and the image receptor when the document handler is moving the sheet past the image receptor; whereby, when the document handler is moved away from the main body of the apparatus, the pane moves with the document handler (*see Suzuki, i.e. Figures 1 and/or 9, Components: 13 – Reading Window, 48 – Roller, 70 – a Lens, and discussions above*). Also see the details in paragraph 8 in the section of "Responses to Argument" above.

**With regard to claim 2**, the claim is drawn to the apparatus of claim 1, further comprising a backing member within the document handler, adjacent the pane (*see Suzuki, i.e. Figure 1 – 37, “Conveying Roller”*).

**With regard to claim 4**, the claim is drawn to the apparatus of claim 2, wherein the backing member is a backing roll (*see Suzuki, i.e. Figure 1 – 37, “Conveying Roller”*).

**With regard to claim 6**, the claim is drawn to the apparatus of claim 1 further comprising means for covering the image receptor when the document handler is positioned



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away from the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 13, “Reading Window”; and in consideration of Paragraph [0014] in the specification of instant application; and/or the exterior casing represented by the “rectangular box”, labeled with “11” in Figure 1*).

**With regard to claim 7**, the claim is drawn to the apparatus of claim 6, the covering means including means for moving the image receptor to an effectively covered position when the document handler is positioned away from the main body of the apparatus (*see Suzuki, i.e. Column 2, lines 60-63, “a drive pulley”*).

**With regard to claim 8**, the claim is drawn to the apparatus of claim 1, wherein the main body of the apparatus includes a main platen (*see Suzuki, i.e. Figure 1 – 12 “Document Glass”*), and further comprising means for moving the image receptor under the main platen in response to the document handler being positioned away from the main body of the apparatus (*see Suzuki, i.e. Column 2, lines 60-63, “a drive pulley”, “first carriage 24”, “second carriage 26”*).

**With regard to claim 9**, the claim is drawn to the apparatus of claim 1, further comprising a second pane operatively disposed in front of the image receptor, the lower pane being mounted within the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 “Document Glass”*).

**With regard to claim 10**, the claim is drawn to the apparatus of claim 9, wherein the second pane is disposed a predetermined distance from the pane when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 “Document Glass”, the figure clearly illustrates “the second pane (or main platen)” (Figure 1 – 12) disposed at a predetermined distance from “the pane” (Figure 1 – 13)*).

**With regard to claim 11**, the claim is drawn to the apparatus of claim 9, wherein the second pane contacts the pane when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 & 13 “Document Glass” & “Reading Window”*).

**With regard to claim 12**, the claim is drawn to the apparatus of claim 1, the image receptor including a photosensitive chip (*see Suzuki, i.e. Figure 1 – 11, “CCD Sensor”*).

**With regard to claim 13**, the claim is drawn to the apparatus of claim 1, wherein the main body of the apparatus includes a main platen, and wherein the main platen is optically equivalent to the pane, relative to the image receptor when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 “Document Glass”*).

**With regard to claim 14**, the claim is drawn to the apparatus of claim 1, wherein the main body of the apparatus includes a main platen, and wherein the main platen and the pane are substantially co-planar when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 “Document Glass” and Figure 1 – 13, “Reading Window” are clearly illustrated to be “substantially co-planar”*).

**With regard to claim 15**, the claim is drawn to the apparatus of claim 1, further comprising a main platen in the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 “Document Glass”*), a lower pane adjacent the pane (*see Suzuki, i.e. Figure 1 – 13*), and wherein the main platen is optically equivalent to the pane in combination with the lower pane, relative to the image receptor when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. column 2, lines 53-57, “image reflected light from a document placed on the document glass 12 or a document passed on the reading windows 13 is projected to CCD sensor by an optical system...”*).

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**With regard to claim 16**, the claim is drawn to the apparatus of claim 1, further comprising a main platen in the main body of the apparatus, a lower pane adjacent the pane, and wherein the main platen and the pane in combination with the lower pane are substantially coplanar when the document handler is positioned against the main body of the apparatus (*see Suzuki, i.e. Figure 1 – 12 & 13 “Document Glass” & “Reading Windows”, disposed at “substantially coplanar” on the body*).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 3 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki** (Patent No. 6,738,167) as applied to claims discussed above, and further in view of **Nakano et al.** (U.S. Patent No. 6,874,778).

Suzuki does not *explicitly* disclose the limitation of “means for urging the backing member against the pane” and “the backing member includes resilient properties”. Although such limitations are commonly known by one of ordinary skill in the art, for purposes of advancing the prosecution, illustrations and discussions of these limitations will also be discussed as following over the prior art, Nakano et al.

Nakano et al. discloses an invention relates to a sheet feeding apparatus, specially disclose “a sheet feeding roller” (*see Nakano et al., i.e. Figure 1 – 2*), further having “roller rubber” (*see Nakano et al., i.e. Figure 1 – 2a*), which has “the resilient property”; and also

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discloses “a press-contact spring” (*see Nakano et al.*, i.e. *Figure 1 – 4*) as a mean for “urging” the roller to make contact with the sheets.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have modified Suzuki to include the limitation of “means for urging the backing member against the pane” and “the backing member includes resilient properties” taught by Nakano et al. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified Suzuki by the teachings of Nakano et al. to the limitation of “means for urging the backing member against the pane” and “the backing member includes resilient properties” taught by Nakano et al. to ensure better or proper transporting of the sheets.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Takida et al. (U.S. Patent No. 6,618,575) disclose an automatic document feeder with a conveying roller and an image reader.
- B. Mui et al. (U.S. Patent No. 7,251,063) disclose an automatic document feeder.
- C. Wenthe, Jr. et al. (U.S. Patent No. 5,488,464) disclose a constant velocity transport for electronic document imaging.
- D. Murakami (U.S. Patent No. 5,912,747) disclose a scanning device, which scan a document in a reverse moving action.
- E. de Koning et al. (U.S. Pub. No. 2002/0135120 A1) disclose a constant force sheet feeder.
- F. Mui et al. (U.S. Pub. No. 2002/0176122) disclose an apparatus and method for calibrating a scanner with a document feeder.

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- G. Honbo et al. (U.S. Pub. No. 2002/0080429 A1) disclose an image reading apparatus and method of setting reading position.
- H. Chen (U.S. Pub. No. 2002/0033968 A1) discloses a duplex scanner capable of calibrating two-sided documents.
- I. Shishido (U.S. Pub. No. 2003/0081275 A1) discloses an image reading apparatus for reading a document image used in image scanner, copier or facsimile machine.
- J. Kinoshita (U.S. Pub. No. 2002/0164175 A1) discloses an image forming apparatus.
- K. Okada (U.S. Patent No. 5,953,574) discloses a sheet feeding apparatus and image forming apparatus.
- L. Tokunoh (U.S. Patent No. 5,515,153) discloses an image forming apparatus with an automatic document feeder having a document-transporting belt.
- M. Nagao et al. (U.S. Patent No. 5,338,018) disclose an automatic document feeder.
- N. Itoh (U.S. Patent No. 5,734,483) discloses an image scanner having contact-type image sensor.
- O. Itoh (U.S. Patent No. 5,610,731) discloses an image scanner having contact-type image sensor movable under automatic document feeder.
- P. de Koning et al. (U.S. Patent No. 6,595,512) disclose a constant force sheet feeder.
- Q. Nakano et al. (U.S. Patent No. 6,874,778) disclose a sheet feeding apparatus and image forming apparatus provided with same.
- R. Anzai (U.S. Pub. No. 2002/0057465 A1) discloses an image input apparatus.
- S. Sekine (U.S. Pub. No. 2002/0135821 A1) discloses an automatic document feeder and image forming apparatus.

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- T. Watanabe et al. (U.S. Pub. No. 2004/0004320 A1) disclose an automatic document feeding apparatus and document reading apparatus.
- U. Hattori et al. (U.S. Pub. No. 2004/0004319 A1) disclose an automatic document feeder and image processing apparatus.
- V. Kobayashi et al. (U.S. Pub. No. 2003/0011121 A1) disclose a document feeding apparatus and document reading apparatus.
- W. Watanabe et al. (U.S. Pub. No. 2004/0065991 A1) disclose an automatic document feeding apparatus.
- X. Hsiao et al. (U.S. Patent No. 2003/0090052) disclose a document feeding apparatus.
- Y. Iwago et al. (U.S. Pub. No. 2004/0062579) disclose a paper discharge tray.
- Z. Nakagawa et al. (U.S. Pub. No. 2003/0026633 A1) disclose a sheet feeding apparatus, image scanning apparatus and image forming apparatus.
- AA. Nakagawa et al. (U.S. Pub. No. 2003/0026633 A1) disclose an image feeding apparatus.
- BB. Sugeta et al. (U.S. Pub. No. 2004/0125412) disclose an image reading apparatus.
- CC. Kanno (U.S. Pub. No. 2004/0047007 A1) discloses a document reading apparatus.
- DD. Kobayashi et al. (U.S. Patent No. 6,837,488) disclose a document feeding apparatus and document reading apparatus.
- EE. Prebola et al. (U.S. Patent No. 4,849,788) disclose an automatic dual mode document registration and edge guide.
- FF. Watanabe et al. (U.S. Patent No. 7,021,618) disclose an ADF.
- GG. Yamada (U.S. Patent No. 5,328,163) discloses a recording sheet feeding device.
- HH. Wada et al. (U.S. Patent No. 6,027,109) disclose a document feeder.

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II. Mui et al. (U.S. Patent No. 6,947,187) disclose an apparatus and method for calibrating a scanner with a document feeder.

JJ. Sheng et al. (U.S. Patent No. 6,512,602) disclose a guide for paper feeder.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacky X. Zheng whose telephone number is (571) 270-1122. The examiner can *normally* be reached on Monday-Friday, 8:30 a.m. - 5 p.m., Alt. Friday Off.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacky X. Zheng/

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Examiner, Art Unit: 2625

September 15, 2008

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625